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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/463,675	05/12/00	BEHLER	A H3033

IM52/0122

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EXAMINER

HARDEE, J

ART UNIT	PAPER NUMBER
1751	11

DATE MAILED:

01/22/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/463,675

Applicant(s)

Behler et al.

Examiner

John R. Hardee

Group Art Unit  
1751



☒ Responsive to communication(s) filed on Jan 16, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-30 is/are pending in the application.

Of the above, claim(s) 23-30 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 11

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of Group IA in Paper No. 10 is acknowledged. The examiner believes that applicant's arguments were addressed in the telephone interview of January 16, which is of record as Paper No. 8. However, the restriction is NOT being made final in this action, in case the attorney believes that any issues have not been dealt with.

2. Regarding the rationale for lack of unity restrictions in 371 cases:

PCT Rule 13.2 states: "Where a group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a **technical relationship** among those inventions involving one or more of the **same or corresponding special technical features**. The expression 'special technical feature' shall mean those technical features that **define a contribution which each of the claimed inventions**, considered as a whole, **makes over the prior art**." (Emphasis added.) The presence of X and Y references in the PCT Search Report is sufficient evidence to conclude that those technical features do not make a contribution over the prior art.

3. Claims 23-30 are withdrawn from consideration by the examiner as being drawn to non-elected inventions. The remaining claims have been searched and examined only to the extent that constituent (d) is an alkoxylated fatty acid.

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4. This application contains claims 23-30 drawn to an invention non-elected with traverse in Paper No. 10. A complete response to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) MPEP § 821.01.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinelt et al., US 5,880,086. The reference discloses laundry softener concentrates comprising 5-40% by weight of a cationic softening agent, 0.1-25% by weight of an ester of an acid of 1 to 22 carbons with a di-, tri- or tetrahydric alcohol of 2-10 carbons, 0-10% by weight of a nonionic dispersing agent, 0-20% by weight of a polyglycol and water (abstract). Suitable cationics include those in col. 2 and the top of col. 3. Particularly preferred esters include mixtures of esters XIII and XV depicted at the top of col. 4 (col. 4, lines 30-33). Ester XIII may be an ethoxylated fatty acid, and ester XV is a monoester of glycerol. This preferred mixture reads on applicant's glycerol-fatty acid monoester and applicant's elected nonionic emulsifier. Suitable glycols include polyethylene glycols of a weight average molecular weight of 400-1000. The exemplified compositions are emulsions or clear solutions. No viscosities or particle sizes are disclosed, but examples 4 and 5 are described as being "low-viscosity". Examiner takes the position that the person of ordinary skill in the surfactant art could reasonably infer the importance of minimizing viscosity based on this disclosure. Examiner takes the position that the recited particle size could be realized in the course of combining and emulsifying the disclosed ingredients, as is disclosed in the reference. This reference differs from the claimed subject matter in that it does not disclose a composition which exemplifies applicant's claims.

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It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a fabric softening composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

8. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinelt et al., US 5,880,086 in view of Severns et al., US 5,531,910. The disclosure of Weinelt is summarized above. Addition of glycerol is not disclosed. Severns discloses fabric softening composition comprising a diesterquat cationic softener (col. 7, lines 58+). Compositions may further comprise glycerol monoesters (col. 22, lines 62+) and nonionic surfactants (col. 17, lines 10+). Addition of liquid carriers, which are principally water, is disclosed at col. 19, lines 22+. Carriers may further comprise low molecular weight alcohols, such as glycerol (col. 17, lines 55-56). It would have been obvious at the time the invention was made to add glycerol to the composition of Weinelt, because Weinelt discloses at col. 5, lines 7-8 that solubilizing agents may be added, and Severns teaches that a mixture of water and glycerol is a useful carrier for softening compositions comprising cationic and nonionic surfactants.

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The data in applicant's specification have been carefully considered, but they are not considered to demonstrate unexpected results commensurate in scope with the claims because data for the elected nonionic emulsifier are not presented.

9. The prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



John R. Hardee

Primary Examiner

January 18, 2001